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10/074,401	02/12/2002	Robert E. McCoy	P/79-4	7032

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ART UNIT	PAPER NUMBER
2169	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/074,401	MCCOY, ROBERT E.	
	Examiner	Art Unit	
	Marc R. Filipczyk	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) *3* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to Applicant's amendment filed on November 26, 2008.

Claims 9 and 10 are newly added thus claims 1, 2 and 4-10 are now pending.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that **Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found** (see 35 U.S.C. 132).

Priority

Claims Priority from Provisional Application 60/268,140 filed on February 12, 2001.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the claim falls within one of the four statutory categories of invention recited in 35 U.S.C. § 101: process, machine, manufacture and composition of matter: The latter three define "things" or "products", while a "process" consists of a series of steps or acts to be performed. A process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform an article or physical object to a different state or thing. *Gottschalk v. Benson, 409 U.S. 63, 71 (1972).*

In the present case, independent claim 10 is a process claim. Claim 1 does not involve transformation of article or physical object to a different state or thing. Further, independent claim 1 does not tie into another statutory class such as a particular apparatus (i.e., computer comprising a physical processor).

Therefore, claim 1, taken as a whole is directed to a mere method, i.e., to only its description, or an abstract idea, hence is non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Matsumoto et al (U.S. Patent No. 6,763,334).

Regarding claim 10, Matsumoto discloses a method for determining which non-internet advertisements direct which web clicks to a website comprising: (abstract)

advertising by an internet company through use of television, radio and or newspaper ads; (see fig. 1, items 15 and 201 and col. 6, lines 45-65 and col. 7, lines 15-45: *mail magazine*)

providing information concerning where said ads are being run demographically and date and time adds are run to a database of a system; (col. 7, lines 4-45, also see col. 6, lines 45-65)

storing information regarding said ads in said database; (see fig. 1, items 15 and 201 and col. 6, lines 45-65 and col. 7, lines 15-45)

storing times of day a person logs onto a site along with location of person logging onto said site using an IP address; (fig. 2, item 62, col. 8, lines 53-64)

subtracting from said system from said stored internet information internet traffic from links from other websites and not from direct logins to said website; (col. 8, lines 53-63, col. 9, lines 46-65 and col. 10, line 8 to col. 11, line 37),

comparing timing and location of advertising to timing and location of when a user logs onto said internet site; (col. 8, lines 53-63, col. 9, lines 46-65 and col. 10, line 8 to col. 11, line 37) and,

determining which source of advertising caused a user to log on to said internet site (fig. 9, col. 9, lines 61-65 and col. 10, lines 31-61 see Advertisers ABC and DEF in fig. 9 and related text).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al (U.S. Patent No. 6,763,334).

Regarding claims 1 and 7, Matsumoto discloses a system and method for determining which non-internet ads direct which web clicks to a web site comprising (abstract):

a database comprising information about a user's non-internet media buys which includes advertising on television, radio and newspaper ads (see fig. 1, items 15 and 201 and col. 6, lines 45-65 and col. 7, lines 15-45: *mail magazine*);

(*Note: mailing magazine is one example of non-internet media buys*)

an index log file optionally comprising a user's IP address and data and time user logs onto said web site (fig. 2, item 62, col. 8, lines 53-64);

said system comparing information from said first database with information from said index log file to determine which of said non-internet ads generated said web clicks and providing said information to a user (col. 10, lines 8-12);

and wherein the user's non internet buys comprises:

date and time of advertising, type of advertising, location of ad and expiration date of the ad (col. 7, lines 4-45, also see col. 6, lines 45-65).

Matsumoto does not expressly teach a second database for storing user's IP address, but does store user's referrer log showing all referring pages from which the user is led to entrance page and also optionally stores the user's IP address in the index log file (62). Note, the user's IP address does not have to be stored because Matsumoto system uses an index URL embedded in the ad which allows for the monitoring of the user's access induced by the advertisement hence the actions of the user are known without the need for user's IP address, however, optionally user's IP address may be stored (col. 8, lines 53-63).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to store user's IP address and referrer log in a second database in the Matsumoto system by simply modifying the index log file (62) to be implemented as a database. One would be motivated to use a second database instead of an index log file to easier manipulate the data stored in the index log file.

Regarding claims 2 and 8, Matsumoto discloses the system further comprises a report that shows which ads generated the web clicks (fig. 9, col. 9, lines 61-65 and col. 10, lines 31-61 see Advertisers ABC and DEF).

Regarding claim 4, Matsumoto discloses the information about a user's media buys further comprises demographics of the ad (col. 6, lines 59-63).

Regarding claims 5 and 9, Matsumoto discloses the information about a user's media buys further comprises cost of the ad (col. 5, lines 22-29).

Regarding claim 6, Matsumoto discloses a report that shows which of the web clicks do not correspond to an ad (col. 9, line 61 to col. 10, line 20).

Response to Arguments

Applicants arguments filed November 26, 2009 have been fully considered but they are not persuasive. The arguments and responses are listed below:

Applicant argues the prior art, Matsumoto, teaches the ad space is space for advertising on the web and does not teach non-web advertising.

Examiner disagrees. Matsumoto teaches internet and non-internet type advertising by utilizing ad space comprising different media type (see fig. 1, item 201 and col. 6, lines 45-65 and col. 7, lines 15-45: *mail magazine* and *website*) such as newspaper or television .

Applicant argues that the prior art does not teach a second database.

Examiner disagrees. As stated in the rejection, Matsumoto teaches storing an index log file comprising a user's IP address (col. 8, lines 32-62). Even though Matsumoto does not explicitly say the index file is a "second database", it is well known to one of ordinary skill in the computer art that a database comprises a file and records for a number of functions, and it is clear that the index of the log file could be used for a number of functions, just as a database, hence, Examiner maintains his view that a simple modification or specific implementation of the index log file is equivalent to a database, as stated in the rejection. Second, Matsumoto compares (analyzes) data from the first database and index log file to determine what advertisements caused users to perform specific actions (see rejection above and col. 8, lines 53-63 and col. 9). The data of the database 15 and user log is analyzed (col. 8, lines 53-63) and result is generated to measure the responses and actions based on the advertisement system (col. 9, lines 46-65 and col. 10, line 8 to col. 11, line 37), specifically note the statistical data and measurements available to affiliates and advertisers using the system in the cited sections above.

Applicant mentions an index URL embedded in the ad.

Examiner is not sure what point the Applicant is trying to make. All types of advertisements comprise embedded links including ads in newspapers and TV.

Applicant previously argued that Matsumoto does not teach which non-internet ads generated the web clicks.

Examiner disagrees. Regarding claims 2 and 8, Matsumoto discloses the system further comprises a report that shows which ads generated the web clicks (fig. 9, col. 9, lines 61-65 and col. 10, lines 31-61 see Advertisers ABC and DEF in fig. 9 and related text).

With regard prior correspondence with regard to claims 4-6, note that it appears that Applicants agree with the rejections on record, see pages 8 and 9 of the 3/13/08 response.

No other arguments have been raised, hence with respect to all the pending claims 1, 2 and 4-10, Examiner respectfully traverses Applicants assertion based on the discussion and rejection cited above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

February 3, 2009
/Marc R Filipczyk/
Examiner, Art Unit 2169

/Mohammad Ali/
Supervisory Patent Examiner, Art Unit 2169